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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,301	02/07/2001	Wakefield Scott Stornetta JR.	8025-1	5656

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/778,301

Applicant(s)

STORNETTA ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

This is in response to an amendment file on February 27<sup>th</sup>, 2004 for letter for patent filed on February 7<sup>th</sup>, 2001 in which claims 1-20 were presented for examination. In the amendment, claims 1 and 11 have been amended, no claim has been canceled, and no claim has been added.

Claims 1-20 remain pending in the letter.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

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In the present case the inventive concept in claim 1-19 only recites an abstract idea. The recited method steps do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Hall (*non patent literature, applicant admitted prior art*)

5. As per claims 1 and 20, Hall teaches a method/system of mediating access to a person's availability information via a communication medium, comprising creating one or more filters (*pac*) each filter including information defining how the availability information is to be presented, a parameter used to identify an individual to whom the access is to be granted, and associating a filter with the individual, identifying the individual when the individual attempts to

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access the filtered information, retrieving the filter associated with the individual, and presenting to the individual up-to-date availability information processed by the associated filter (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

6. As per claim 2, Hall teaches a method of deactivating said one or more filters upon satisfaction of a preset condition relating to said filter (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

7. As per claim 3, Hall teaches a method wherein the filtered information is prevented for access by the individual after said one or more filters is deactivated (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

8. As per claim 4, Hall teaches a method of identifying the individual is by digital signature (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

9. As per claim 5, Hall teaches a method of associating a token with each filter; giving notice of the token to the individual; and use of the token for identifying the individual and determination of the associated filter (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

10. As per claim 6, Hall teaches a method wherein said filtered information is a filtered view of a calendar of the person (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

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11. As per claim 7, Hall teaches a method wherein each of the one or more filters presents a different version of the person's availability information (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

12. As per claims 8 and 10, Hall teaches a method wherein the communication medium is telephony or instant messaging (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

13. As per claim 9, Hall teaches a method of identifying the individual is by caller ID (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

14. As per claim 11, Hall teaches a method of mediating access to a person via a communication medium, comprising creating one or more filters, each filter including information defining an individual's ability to arrange access to the person, and at least one parameter used to identify the individual to whom the access is to be granted identifying the individual when the individual attempts to arrange access to the person, determining an appropriate filter based on identification of the individual, and arranging for access to the person by the individual within the constraints established by the appropriate filter (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

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15. As per claims 12, Hall teaches a method wherein said step of arranging for access to the person includes presenting to the individual up-to-date availability information of the person (*see introduction paragraph 4, section 2.2, 3.1, 3.2, 4, 4.1, 4.2, and 6*).

16. As per claims 13-16, Hall teaches a method wherein the up-to-date availability information is presented through the appropriate filter upon identification of the individual and dynamically updated by the appropriate filter and instantaneous availability information of the person is presented to the individual when the individual is identified and is based on detection of the person's location by GPS (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

17. As per claims 17, Hall teaches a method wherein the communication medium is instant messaging on a global electronic network and whether access to the person by any individual depends on the individual identified (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

18. As per claims 18 and 19, Hall teaches a method of giving a token to the individual, said token for use in identifying the individual includes use of the token and one other identification means to authenticate the individual (*see introduction paragraph 4, section 2.2, 3.1, 3.2 4, 4.1, 4.2, and 6*).

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***Response to Arguments***

19. Applicant's arguments filed February 27<sup>th</sup>, 2004 have been fully considered but they are not persuasive.

a. Applicant argues that the prior art fail to teach an inventive concept with a "filter for processing the availability information and to produce filtered information". Examiner respectfully disagrees with Applicant's characterization of the prior art. Hall teaches an inventive concept wherein email are channeled through an email agents and filtered by providing a categorization based on which correspondent are presumed to channel. The filtering agents are used for advertisement survey and other annoying unwanted junk mail. The filter rejects any message that is not digitally signed by an expected correspondent. Therefore, the availability of information is any message available to be channeled to user that is filtered before it is channeled to the user (*see section 3.1 and 3.2*).

b. Applicant's amendment to claims 1 and 11 is insufficient to overcome the 101 rejection.

***Conclusion***

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**



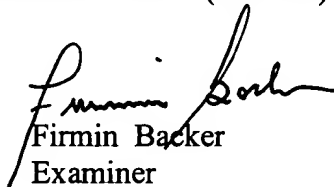
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Firmin Backer  
Examiner  
Art Unit 3621

April 20, 2004